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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/821,191	03/29/2001	Martin A. Kenner	56095US002	4517

32692 7590 08/02/2004

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EXAMINER
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YOUNG, JOHN L

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 08/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/821,191

Applicant(s)

KENNER ET AL.

Examiner

John L Young

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-80 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-80 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

JOHN LEONARD YOUNG, ESQ.  
PRIMARY EXAMINER

*[Signature]*  
7-26-2004

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☒ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **NON-FINAL REJECTION**

**(Paper#7/26/2004)**

### **DRAWINGS**

1. This application has been filed with drawings that are considered informal; however, said drawings are acceptable for examination and publication purposes. The review process for drawings that are included with applications on filing has been modified in view of the new requirement to publish applications at eighteen months after the filing date of applications, or any priority date claimed under 35 U.S.C. §§119, 120, 121, or 365.

### **CLAIM REJECTIONS — 35 U.S.C. §103( a )**

2. **REJECTIONS MAINTAINED** for claims 2-28, 30-40, 42-68 & 78-80.
3. **NEW CLAIM REJECTIONS** presented for claims 1, 29, 41 & 69-77.

### **NEW CLAIM REJECTIONS — 35 U.S.C. §103( a )**

A prior Office action recites the substance of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action.

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4. Claims 1, 29, 41 & 69-77 are rejected under 35 U.S.C. §103(a) as being unpatentable over Morton 6,327,572; class 705/10 (12/04/2001) [US f/d: 12/06/1999] (herein referred to as "Morton").

As per claim 1, Morton (col. 6, ll. 10-67; FIG. 4; col. 2, ll. 7-67; col. 3, ll. 38-67; col. 8, ll. 30-67; FIG. 2; and whole document) shows: "A method comprising: posting a note at a content provider, wherein the content provider is a first party; performing an activity related to the note, wherein the activity is performed by a content recipient, and wherein the content recipient is a second party; and, providing payment to a third part based upon the activity."

Morton lacks an explicit recitation of "wherein the content provider is a first party; performing an activity related to the note, wherein the activity is performed by a content recipient, and wherein the content recipient is a second party; and, providing payment to a third part based upon the activity. . . ."

It would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure of Morton (col. 6, ll. 10-67; FIG. 4; col. 2, ll. 7-67; col. 3, ll. 38-67; col. 8, ll. 30-67; FIG. 2; and whole document) implicitly shows "wherein the content provider is a first party; performing an activity related to the note, wherein the activity is performed by a content recipient, and wherein the content recipient is a second party; and, providing payment to a third part based upon the activity. . . ." and it would have

been obvious to modify and interpret the disclosure of Morton cited above as showing "wherein the content provider is a first party; performing an activity related to the note, wherein the activity is performed by a content recipient, and wherein the content recipient is a second party; and, providing payment to a third part based upon the activity. . . ." because modification and interpretation of the cited disclosure of Morton would have provided a "viral marketing system in connection with an information service. . . ." (see Morton (col. 10, ll. 12-20)) based on the motivation to modify Morton so that "*the number of marketing opportunities can grow as the number of customers grows.*" (See Morton (col. 10, ll. 5-9)).

As per claim 29, Morton (the ABSTRACT; col. 6, ll. 10-67; FIG. 4; col. 2, ll. 7-67; col. 3, ll. 38-67; col. 8, ll. 30-67; FIG. 2; and whole document) shows: "A method comprising: posting a note at a content provider, wherein the content provider is a first party; executing a note program at a content recipient so as to download the note without resort to a cut or copy operation and without downloading a web page of the content provider, wherein the content recipient is a second party; and providing payment to a third party based upon the note."

Morton lacks an explicit recitation of "wherein the content provider is a first party; executing a note program at a content recipient so as to download the note without resort to a cut or copy operation and without downloading a web page of the content provider, wherein the content recipient is a second party; and

providing payment to a third party based upon the note. . . .” It would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure of (the ABSTRACT; col. 6, ll. 10-67; FIG. 4; col. 2, ll. 7-67; col. 3, ll. 38-67; col. 8, ll. 30-67; FIG. 2; and whole document) implicitly shows “wherein the content provider is a first party; executing a note program at a content recipient so as to download the note without resort to a cut or copy operation and without downloading a web page of the content provider, wherein the content recipient is a second party; and providing payment to a third party based upon the note. . . .” and it would have been obvious to modify and interpret the disclosure of Morton cited above as showing “wherein the content provider is a first party; executing a note program at a content recipient so as to download the note without resort to a cut or copy operation and without downloading a web page of the content provider, wherein the content recipient is a second party; and providing payment to a third party based upon the note. . . .” because modification and interpretation of the cited disclosure of Morton would have provided a “viral marketing system in connection with an information service. . . .” (see Morton (col. 10, ll. 12-20)) based on the motivation to modify Morton so that “*the number of marketing opportunities can grow as the number of customers grows.*” (See Morton (col. 10, ll. 5-9)).

Independent claim 41 is rejected for substantially the same reasons as independent claim 1.

As per claim 69-77 Morton (col. 6, ll. 10-67; FIG. 4; col. 2, ll. 7-67; col. 3, ll. 38-67; col. 8, ll. 30-67; FIG. 2; and whole document) shows the method of claim 1 and subsequent base claims depending from claim 1.

Morton lacks explicit recitation of some of the elements of claims 69-77, even though Morton implicitly shows same.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure of Morton cited above implicitly shows the elements and limitations of claims 69-77 and it would have been obvious to modify and interpret the disclosure of Morton cited above as showing the limitations of claims 69-77, because modification and interpretation of the cited disclosure of Morton would have provided a "viral marketing system in connection with an information service. . . ." (see Morton (col. 10, ll. 12-20)) based on the motivation to modify Morton so that "*the number of marketing opportunities can grow as the number of customers grows.*" (See Morton (col. 10, ll. 5-9)).

**5. PRIOR CLAIM REJECTIONS — 35 U.S.C. §103( a )**

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3. Claims ~~1-68~~2-28, 30-40, 42-68 & 78-80 are rejected under 35 U.S.C. §103(a) as being unpatentable over Morton 6,327,572; class 705/10 (12/04/2001) [US f/d: 12/06/1999] (herein referred to as "Morton").

As per claims 2-28, Morton (col. 6, ll. 10-67; FIG. 4; col. 2, ll. 7-67; col. 3, ll. 38-67; col. 8, ll. 30-67; FIG. 2; and whole document) shows the method of claim 1 and subsequent base claims depending from claim 1.

Morton lacks explicit recitation of the elements and limitations of claims 2-28, even though Morton suggests same.

Official Notice is taken that both the concepts and the advantages of the elements and limitations of claims 2-28 were well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claims 2-28, because such inclusion would have provided a "viral marketing system in connection with an information service. . . ." (See Morton (col. 10, ll. 12-20)).



As per claims 30-40, Morton (col. 6, ll. 10-67; FIG. 4; col. 2, ll. 7-67; col. 3, ll. 38-67; col. 8, ll. 30-67; FIG. 2; and whole document) shows the method of claim 29 and subsequent base claims depending from claim 29.

Morton lacks explicit recitation of the elements and limitations of claims 30-40, even though Morton suggests same. Official Notice is taken that both the concepts and the advantages of the elements and limitations of claims 30-40 were well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claims 30-40, because such inclusion would have provided a "viral marketing system in connection with an information service. . . ." (See Morton (col. 10, ll. 12-20)).

As per claims 42-68, Morton (col. 6, ll. 10-67; FIG. 4; col. 2, ll. 7-67; col. 3, ll. 38-67; col. 8, ll. 30-67; FIG. 2; and whole document) shows the method of claim 41 and subsequent base claims depending from claim 41.

Morton lacks explicit recitation of the elements and limitations of claims 42-68, even though Morton suggests same.

Official Notice is taken that both the concepts and the advantages of the elements and limitations of claims 42-68 were well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claims 42-68, because such inclusion would have provided a "viral marketing system in connection with an information service. . . ." (See Morton (col. 10, ll. 12-20)).

4. Claims ~~69-70, 75 & 78~~~~1-68~~ are rejected under 35 U.S.C. §103(a) as being unpatentable over Morton 6,327,572; class 705/10 (12/04/2001) [US f/d: 12/06/1999] (herein referred to as "Morton").

As per claim 78 Morton (col. 6, ll. 10-67; FIG. 4; col. 2, ll. 7-67; col. 3, ll. 38-67; col. 8, ll. 30-67; FIG. 2; and whole document) shows the method of claim 1 and subsequent base claims depending from claim 1.

Morton lacks explicit recitation of the elements and limitations of claim 78, even though Morton suggests same.

Official Notice is taken that both the concepts and the advantages of the elements and limitations of claim 78 were well known and expected in the art at the time of the invention. It

would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claims 69-70, 75 & 78, because such inclusion would have provided a "viral marketing system in connection with an information service. . . ." (See Morton (col. 10, ll. 12-20)).

As per claim 79 Morton (col. 6, ll. 10-67; FIG. 4; col. 2, ll. 7-67; col. 3, ll. 38-67; col. 8, ll. 30-67; FIG. 2; and whole document) shows the method of claim 29 and subsequent base claims depending from claim 29.

Morton lacks explicit recitation of the elements and limitations of claim 79, even though Morton suggests same.

Official Notice is taken that both the concepts and the advantages of the elements and limitations of claim 79 were well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claim 79, because such inclusion would have provided a "viral marketing system in connection with an information service. . . ." (See Morton (col. 10, ll. 12-20)).

As per claim 80, Morton (col. 6, ll. 10-67; FIG. 4; col. 2, ll. 7-67; col. 3, ll. 38-67; col. 8, ll. 30-67; FIG. 2; and whole document) shows the method of claim 41 and subsequent base claims depending from claim 41.

Morton lacks explicit recitation of the elements and limitations of claim 80, even though Morton suggests same.

Official Notice is taken that both the concepts and the advantages of the elements and limitations of claim 80 were well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claim 80, because such inclusion would have provided a "viral marketing system in connection with an information service. . . ." (See Morton (col. 10, ll. 12-20)).

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### RESPONSE TO ARGUMENTS

6. NOTE: As per claims 2-28, 30-40, 42-68 & 78-80, the Official Notice evidence presented in the prior Office actions is deemed admitted evidence.

It is well settled in the law that "If Applicant does not seasonably traverse the well known statement during examination, then the object of the well known statement is taken to be admitted prior art. *In re Chevenard*, 139 F.2d 71, 60 USPQ 239 (CCPA 1943). A seasonable challenge constitutes a demand for evidence made as soon as practicable during prosecution. Thus, Applicant is charged with rebutting the well known statement in the next reply after the Office action in which the well known statement was made." (See MPEP 2144.03).

In this case, Applicant's responses lack a demand for evidence of the Official Notice presented in prior Office Actions for the claims 2-28, 30-40, 42-68 & 78-80; therefore, the Official Notice evidence presented in prior Office actions is deemed admitted, and no further references are required in support of said Official Notice evidence concerning claims 2-28, 30-40, 42-68 & 78-80.

7. Applicant's arguments concerning claims 1, 29, 41 & 69-77, are moot pursuant to new grounds of rejection.

### CONCLUSION

8. Any response to this action should be mailed to:

Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450

Any response to this action may be sent via facsimile to either:

(703)305-7687 (for formal communications EXPEDITED PROCEDURE) or

(703) 305-7687 (for formal communications marked AFTER-FINAL) or

(703) 746-7240 (for informal communications marked PROPOSED or DRAFT).

Hand delivered responses may be brought to:

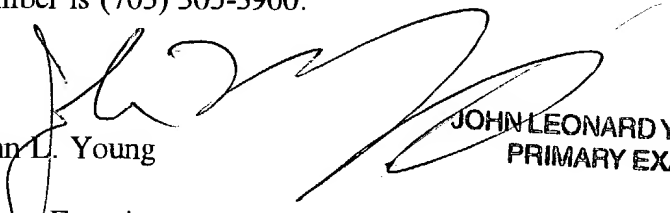
Seventh Floor Receptionist  
Crystal Park V  
2451 Crystal Drive  
Arlington, Virginia.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L. Young who may be reached via telephone at (703) 305-3801. The examiner can normally be reached Monday through Friday between 8:30 A.M. and 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, may be reached at (703) 305-8469.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

John L. Young  
Patent Examiner



JOHN LEONARD YOUNG, ESQ.  
PRIMARY EXAMINER

July 26, 2004